

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Schon et al. (U.S. Publication No. 2003/0097131).

Schon et al. discloses an intramedullary nail (4) having a proximal end, a distal end and a central cylindrical elongated body with a chamfered end and at least one slot (32) where said device comprises an attaching means to a bone. Said intramedullary nail is cannulated (see Figure 2) comprising a round cross-section with a central elongated body. The intramedullary nail is adapted with said attaching means by way of a proximal fastener hole (48) and a distal fastener hole (16) where a fastener (50) is inserted into at least one of the fastener holes. Said fastener is configured and dimensioned for insertion in at least one of said fastener holes, further comprising a threaded hole for insertion of a screw. With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Schon et al. which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458,459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Examiner's Response to Arguments

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection. The amendments filed on July 31, 2009 overcome the Perry reference but do not put the case into condition for allowance.

In regards to claims 1-9 being rejected under 35 USC 102(b) as being anticipated by Schon (U.S. Application number 2003/0097131) herein referred to as Schon.

Applicant's Response to Arguments

The present application claims a device for treatment or fixation of a fractured, damaged or deteriorating bone or bones in a mid-foot region, said device having a proximal end, a distal end, and a central elongated body, the device comprising an attaching means to the bone or bones of a foot such that the attaching means secures the mid-foot region – specifically securing support along the medullary canal, the canal extending into and through the mid-foot region starting first at the metatarsal, next into the medial cuneiform, next into the navicular, and finally into the talus bone.

In addition, the intramedullary nail of the present application has a central cylindrical elongated body with a chamfered end, as defined by a reduction in diameter by a 45 degree chamfer between the cylindrical body and the right angle end, and slots for optionally securing the navicular bone and/or the medial cuneiform bone. The intramedullary nail of Schon does not describe nor claim neither at least one slot for securing the navicular bone or the medial cuneiform bone nor both the navicular bone and the medial cuneiform bone nor a chamfered cylindrical end. As shown in Fig. 1 and Fig. 2 of the present application, a unique defining structural feature is the chamfer on the proximal end [11] of the central cylindrical elongated body, wherein a sufficient portion of the chamfered end is inserted into the talus bone so that at least one proximal fastener hole reaches far enough into the talus bone to fully secure the device with fasteners through the fastener hole thereby securing said mid-foot region by providing support along the medullary canal, said canal extending into and through said mid-foot region starting first at the metatarsal, next into the medial cuneiform, next to the navicular, and finally into the talus bone.

The device and design of Schon does not teach any concept regarding the securing of the mid-foot region as described and shown in the present application, by use of the intramedullary nail of Schon. and, in fact, the device and design taught by Schon could not be used to provide the support needed to secure the mid-foot region. In fact, the device, design, and utility of the nail taught by Schon provides an inadequate result known to either immediately or ultimately fail in all patients for which it has been used.

In response to examiner's argument "that the present application has a chamfered end, as defined by a reduction in diameter by a 45 degree chamber between the cylindrical body and the right angle end, and slots for optionally securing the navicular bone and/or the medial cuneiform bone does not include certain features of Applicant's invention, the limitations on which the Applicant relies (i.e., a reduction in diameter by a 45 degree chamber between the cylindrical body and the right angle end) are not stated in the claims", this issue has now been fully addressed and corrected below in the section entitled "amended claims".